

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH P. TRAEGER, MARK A. TRAEGER
and RANDOLPH J. TRAEGER

Appeal No. 2003-1982
Application No. 09/620,830

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 and 7-9, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of seating the end of a post. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ferguson	4,881,342	Nov. 21, 1989
Kosinski	6,397,520	Jun. 4, 2002

Claims 1, 2, 4 and 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferguson in view of Kosinski.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 14) and the final rejection (Paper No. 11) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 13) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Considering the rejection in view of this guidance leads us to conclude that it cannot be sustained. Our reasons for arriving at this decision follow.

As expressed in independent claim 1, the appellants' invention comprises the steps of providing a cavity, placing the end of a post within the cavity and establishing a space disposed to one side of the post, introducing a water expansible, organic fiber, pellet material to the space to produce a fill, and introducing water to the fill to cause expansion and consolidation of the pellet material into a water pervious cake that is capable of firmly holding the end of the post without tamping. The examiner is of the view that all of the subject matter recited in claim 1 is disclosed by Ferguson except for

filling the cavity with the required fill and introducing water into the fill. However, the examiner has concluded that it would have been obvious to one of ordinary skill in the art to modify Ferguson in such a manner as to meet the terms of claim 1, in view of the teachings of Kosinski, taking “official notice that it is old and notorious[ly] well known in the horticultural arts to partially fill a container with a potting medium, place a post in the medium, and continue to fill the container with the potting medium, and then introduce water into the medium” (Paper No. 11, page 2). The appellants argue that the claimed steps are not taught by the references, and that suggestion does not exist for combining the teachings of the references in the manner proposed by the examiner.

Ferguson is directed to a plant support device and display stand. The reference discloses, along with other elements, a potted plant container C filled with soil and an elongated plant support rod 10 that is “insertable into the soil at the base of a growing plant” (column 2, lines 6 and 7) “to a sufficient depth to be self-supporting in the soil” (column 3, lines 9 and 10). Ferguson is not concerned with seating the end of a post. Moreover, even if rod 10 were considered to be a post, contrary to the position taken by the examiner, from our perspective none of the steps recited in claim 1 are disclosed or taught by Ferguson. Whereas claim 1 requires the steps of “providing a cavity for receiving the end of the post” and “placing the end of the post within the cavity and establishing a space within the cavity disposed to one side of the post,” Ferguson does not first form a cavity, but merely inserts rod 10 into the soil at the base of a growing

plant to a depth sufficient enough to support it, and does not establish a space in a cavity to one side of the post. Nor does Ferguson disclose or teach introducing any material into a cavity, much less a water expansible, organic fiber, pellet material to produce a fill, and it follows that Ferguson thus does not add water to cause expansion and consolidation of the fill into a water pervious cake capable of supporting the rod.

Kosinski discloses a soil substitute for promoting plant growth which comprises balls of natural or synthetic organic polymer fibers. There is no teaching in Kosinski of supporting a post or the like in this soil substitute. There also is no indication that upon application of water this soil substitute expands and consolidates into a water pervious cake that is capable of firmly holding the end of a post.

We fail to perceive any teaching, suggestion or incentive in either reference, or in the "official notice" taken by the examiner, which would have led one of ordinary skill in the art to modify the Ferguson method in such a manner as to render the method disclosed in claim 1 obvious. Moreover, even if Ferguson were modified by replacing the soil with Kosinski's soil substitute, the result would not give rise to the method recited in the appellants' claim 1.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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